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| 10/576,610      | 04/21/2006  | Toshio Yamauchi      | 0969-0187PUS1       | 2059             |

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

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| EXAMINER |
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MORGAN, EMILY M

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| ART UNIT | PAPER NUMBER |
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3677

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|-------------------|---------------|
| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

05/13/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/576,610 | <b>Applicant(s)</b><br>YAMAUCHI, TOSHIO |  |
|                              | <b>Examiner</b><br>EMILY M. MORGAN   | <b>Art Unit</b><br>3677                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 16 is/are pending in the application.
- 4a) Of the above claim(s) 3-9, 11, 14, 15 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant claims "...a guide wall on an inner peripheral side thereof, the two guide walls..." in the fourth paragraph of claim 1. Applicant has claimed a guide wall, then immediately claims two. Applicant later claims "each of the guide walls" but is considered proper due to the use of a chain of these individual pieces that all have a guide wall.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

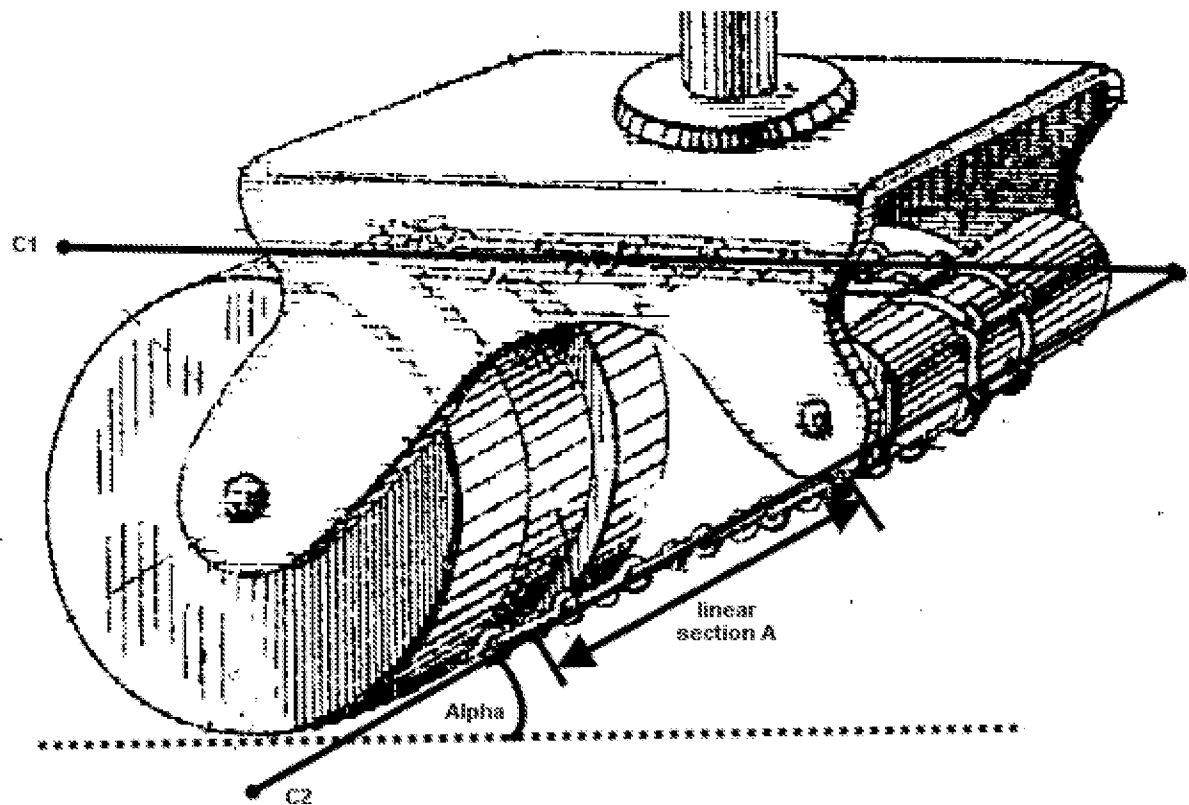
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over patent 1066754 to Rison in view of patent 4752105 to Barnard.

Regarding claim 1, Rison discloses a caster (figure, shown below) comprising: first 19 and second 21 wheels disposed forward and back and an endless wrap-around member 22 wrapped around the first 19 and second 21 wheels, the first and second

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wheels having common tangents C1 and C2, the common tangent C2 having an angle (alpha) with respect to a ground surface, wherein the wraparound member 22 is a continuous endless belt formed by connecting a plurality of pieces (links, line 56) via a plurality of connecting members, the wraparound member having a linear portion A formed along at least the common tangent C2 of the wheels (all shown below). Rison does not disclose the specified structure of the wraparound member.



Barnard discloses wrap around tread (figure 2) wherein the tread is made of pieces 40 independently formed as a body having a wheel guide section 12.1 on an inner peripheral side thereof (figure 3); the wheel guide section 12.1 having a connecting section 39 (figure 8) that faces the adjacent pieces of either side thereof, a contacting section 40.3 and 40.4 on each side of (figure 4) of the connecting section 39

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facing the adjacent pieces, each end of the connection section 39 along an axis of rotation of each of the wheels being provided (the connecting surfaces are all parallel to the axis of the wheel), with a guide wall 12.2 on an inner peripheral side of the connecting section 39 (figure 3), and when viewed along the axis of rotation of the wheels, each of the contacting sections 40.3, 40.4 is seen as a linear section that extends parallel to the contacting sections of the adjacent pieces (figure 2), and that is perpendicular to the linear portion A of the common tangent C2 of the wheels (each piece is seeming perpendicular to the linear length between the two wheels, figure 2), wherein each of the guide walls 12.2 of the wheel guide section 12.1 includes an inclined surface section (creating acute angle 48), the inclined surface section being adapted to form a groove that is substantially V- shaped between each of the adjacent pieces (figure 2), thereby enabling the wraparound member to bend along an outer periphery of each of the first and second wheels (figure 2), wherein connecting sections 39 are provided between the contacting section 40.3 and 40.4 and the guide wall 12.2 of each of the pieces, and wherein the plurality of pieces 40 are connected by at least one connecting member (wires 41, figure 3) which extending through a connecting hole 43 provided in each of the pieces.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to place a guide wall 12.2 on all sides of the wheels, not just between the two wheels, since it has been held that mere duplication of the essential working parts of a device involves only routine skilled the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. The guide wall 12.2 is shaped so that the wheels on either

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side of it will contact the guide and ensure that the track will stay in the proper place on the caster. Placing such a guide wall on either side of the track piece to contact one wheel on each side would provide another layer of insurance that the track will stay in its proper place.

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the treads of Barnard in place of the links of Rison, motivated by the desire to further enable the caster of Rison to carry itself over inequalities in the floor (line 13) just as Barnard uses the tread to go over obstacles in the land. Rison also discloses that other flexible members may be applicable to the caster disclosed (lines 55-60). This would be an easy exchange from links to the Barnard tread in that the wheels of Rison are centrally grooved, which would accommodate the central guide pieces of Barnard.

Since the contacting sections of the adjacent pieces abut respectively against each other along a linear portion (shown in figure 2), when the pieces are applied to the Rison caster, the effect would be the same along the linear portion of tangent C2. The Barnard applied tread along the linear portion A of the common tangent C2 is capable maintaining a linear condition and is prevented from being dented, so that even when the linear portion A is pushed by a force from an outside, the linear portion A is capable of serving as an anti-sticking plate. This is done because the pressure faces are adapted in Barnard to prevent reverse bending of the track member (column 1, line 43).

Regarding claim 16, Rison as modified discloses the caster according to claim 1, wherein the connecting members (wires of Barnard) extend in a direction perpendicular to the direction of the axis of rotation of each of the wheel. The wires extend around the edges of the wheels, which is perpendicular to the axis of rotation about the wheel.

### ***Response to Arguments***

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Regarding the claim for foreign priority, applicant has filed that this is the national stage entry of a PCT, and this has been previously acknowledged. Applicant has not filed any foreign priority documents.

Regarding the amendment to the specification, examiner appreciates applicant's consideration and has dropped the objection.

Regarding the objections to claim 1, the amendments have satisfied examiner's objections and have therefor been dropped.

Regarding the objection to the drawings, since the objections to claim 1 have been fixed, the objection to the drawings has also been rescinded.

Regarding Rison, examiner concedes that this reference does not teach the structure to the wrap around.

Regarding Barnard, due to the amendment to claim 1, examiner notes the difference between the ridge 12.2 and the two separated guide walls 30 of application, and has addressed the differences in the rejection above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMILY M. MORGAN whose telephone number is (571)270-3650. The examiner can normally be reached on Monday-Thursday, alternate Fri, 7:30am to 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached on 571-272-6987. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor Batson/  
Supervisory Patent Examiner, Art Unit 3677

Emm  
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